

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

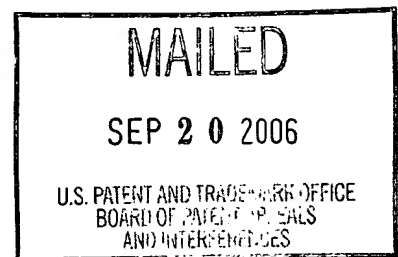
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREAS SASSE

Appeal No. 2006-2510
Application No. 09/600,458

ON BRIEF



Before HAIRSTON, BLANKENSHIP, and MACDONALD, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-12 and 15, which are all the claims remaining in the application.

We affirm.

BACKGROUND

The disclosed invention relates to a method for menu presentation of value added services on a mobile terminal in a mobile communications system.

Representative claim 1 is reproduced below.

1. A method for terminal assisted menu presentation of value added services in mobile communication systems where the value added services are accessible via value added services nodes where objects are loaded in a mobile station comprising a mobile terminal and a subscriber identity module, comprising the steps of:

communicating between a subscriber and a value added services node relative to value added services offered with the objects, the objects including at least one of executable programs, functions, and data, and wherein an object contains at least an abbreviated form of the menu of a value added service;

controlling, modifying, or executing the objects via the wireless interface of the mobile communication system;

verifying with the object the technical capabilities of the mobile station and the objects automatically adapting to the technical capabilities of the mobile station;

subsequently selecting and loading into the mobile station an object suitable to the technical capabilities of the mobile station, wherein the technical capabilities of the mobile station are stored in a special database;

wherein the step of communicating between a subscriber and a value added services node includes loading the objects into the mobile station with a short message service;

communicating a short message from the value added services node to the mobile station containing the version number of the object available from the value added services node;

comparing the version number of the available object with a version number of the object available in the mobile station and, if a more up-to-date

object is available, loading the more up-to-date object into the mobile station;
and

communicating a short message from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station.

The examiner relies on the following references:

Michaels et al. (Michaels)	US 6,011,976	Jan. 4, 2000 (§ 102(e) date Apr. 19, 1996)
Basso et al. (Basso)	US 6,317,131 B2	Nov. 13, 2001 (filed Jul. 10, 1998)
Sugita	US 6,564,048 B1	May 13, 2003 (effective filing date Dec. 18, 1996)
Eul ¹	DE 19610840 A1	Sep. 25, 1997

Claims 1-12 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eul, Basso, and Sugita.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Eul, Basso, Sugita, and Michaels.

We refer to the Final Rejection (mailed Jun. 30, 2005) and the Examiner's Answer (mailed Mar. 28, 2006) for a statement of the examiner's position and to the Brief (filed Dec. 22, 2005) and the Reply Brief (filed May 30, 2006) for appellant's position with respect to the claims which stand rejected.

¹ Federal Republic of Germany patent, with English translation.

OPINION

The examiner finds that Eul discloses a procedure for loading value added services (electronic games) in a mobile station substantially as required by instant claim 1. However, the examiner finds that Eul fails to teach the limitations of claim 1 relating to the verification of the technical capabilities of the terminal and loading an object suitable to the technical capabilities, and the limitations relating to comparing the version number of the available object with a version number of the object available on the mobile station and loading the more up-to-date object if indicated. The examiner concludes that, based on prior art teachings of Basso and Sugita suggesting addition of the features to the method described by Eul, the subject matter as a whole would have been obvious to the artisan at the time of invention. (Answer at 3-5.)

Appellant in response, at pages 8 and 9 of the Brief, alleges individual deficiencies in the references. However, as the examiner indicates, the rejection is not for anticipation by any one of the applied references. Nonobviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) (citing In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). Appellant does not submit any reasoning in support of why the skilled artisan would have considered it nonobvious to ensure that the latest version of the value added service (i.e., game) resides on the mobile station and that the game be

adapted to the technical capabilities of the station, in view of the evidence provided by the rejection.

Appellant, in summary of the arguments, alleges that the three applied references fail to teach the steps of communicating a “short message” from the value added services node to the mobile station containing the version number of the object available from the value added services node, and communicating a “short message” from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station. (Brief at 9.)

The examiner reiterates, in the Answer (at 9-12), where the allegedly absent features are found in the references. Moreover, Eul discloses that the mobile station may receive menus for loading games, the games themselves, or data associated with games, via any suitable channel -- including the “Short Message Service” channel. Eul translation p. 8, 2nd ¶; p. 13, 2nd ¶; p. 14, 1st ¶. While it is true that Eul does not disclose communicating a “short message” from the value added services node to the mobile station containing the version number of the object available from the value added services node, Eul is not relied upon for the version number of the object. With respect to communicating a “short message” from the value added services node to the subscriber identity module for updating the display (e.g. Eul’s LCD display described at page 12 of the translation), we do not read appellant’s remarks as contending that

patentability resides on the references failing to show sending a short message to a subscriber identity module (SIM). We observe that it is not apparent to us that the translation of Eul describes the memory for reception of messages relating to menu-driven display operations as SIM memory, although the artisan might consider the reference to contain terms synonymous with such memory. In any event, however, the Michael reference demonstrates that it was conventional in the art to send messages for display, via Short Message Service, to a rolling buffer in the SIM card. See Michaels at col. 1, ll. 10-23.

Appellant also submits that Eul and Sugita disclose mobile communication systems. Basso has no disclosure or suggestion of a mobile communication system, according to appellant. Appellant concludes that Basso is not in the same field of endeavor as the first two references, and cannot be properly combined with Eul and Sugita to show obviousness. (Brief at 9.)

Whether a reference in the prior art is “analogous” is a fact question. In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Appellant thus contests the examiner’s finding that Basso is analogous prior art. Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. Id. at 658-59, 23 USPQ2d at 1060.

Appellant's remarks suggest that appellant's field of endeavor is limited to mobile communication systems, which somehow excludes Basso from being considered as analogous art. Actually, appellant's specification says (1st page) that the invention relates to "a method for terminal assisted menu presentation of value added services in mobile communication systems according to the preamble of patent claim 1." Basso relates to methods for improving the quality of a multimedia display based on terminal capabilities. (E.g., col. 1, ll. 9-13.) We do not find the Basso disclosure to be limited, notwithstanding appellant's apparent view (Reply Brief at 4), to improving the quality of a multimedia display based on "computer" terminal capabilities. We thus find substantial support for the examiner's position that Basso is from the same field of endeavor as appellant's invention.

Moreover, even were we to assume that Basso is not in the same field of endeavor, the reference is reasonably pertinent to the particular problem with which the inventor is involved, and thus analogous art. Teachings regarding the quality of a multimedia display are reasonably pertinent to problems relating to terminal assisted menu presentation of value added services in mobile communication systems.

Appellant also seems to hold that the evidence does not support the examiner's finding of a suggestion or motivation to combine the references.² The view appears to

² The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact. In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

be based, however, on the examiner's separate finding that the references can be combined -- i.e., are analogous art -- or on the asserted absence of express suggestion for the combination in the text of the patents. In any event, we find, consistent with the examiner's position, that the references considered together would have suggested the improvements to the method described by Eul. The suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art. Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997); see also Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985) ("[T]he suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all of the references used to show obviousness. 'Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.'") (quoting In re Keller, 642 F.2d at 425, 208 USPQ at 881).

We therefore sustain the § 103 rejection of claim 1, and of claims 2-12 and 15, not separately argued. See 37 CFR § 41.37(c)(1)(vii).

We also sustain the separate § 103 rejection of claim 8. We do not find appellant's arguments (Brief at 11) persuasive of error in the rejection. For example, appellant does not address the examiner's finding of a motivation for combining Michaels with the other references, which is based on express suggestion in the reference. (Answer at 7.)

Appeal No. 2006-2510
Application No. 09/600,458

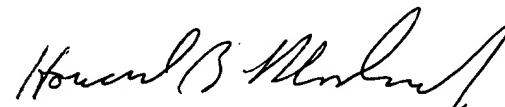
CONCLUSION

The rejection of claims 1-12 and 15 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED


KENNETH W. HAIRSTON
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2006-2510
Application No. 09/600,458

JOHN F. HOFFMAN
BAKER & DANIELS
111 EAST WAYNE STREET
SUITE 800
FORT WAYNE, IN 46802